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| 10/038,575 | 01/08/2002 | Joachim Schicke | 31512-176923 | 1434 |

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VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

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| EXAMINER |
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ROSS, DANA

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| ART UNIT | PAPER NUMBER |
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3722

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,575

Applicant(s)

SCHICKE, JOACHIM

Examiner

Dana Ross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47 and 48 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-25, 27-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This is a second office action, final rejection on Application No. 10/038575 in response to the amendment filed on October 21, 2003.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-25, and 27-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,830,126 (Ringe) in view of U.S. Pat. No. 5,217,424 (Pallmann) or U.S. Pat. No. 975,563 (Morgan).

Ringe teaches the method and apparatus cutter with a knife blade for severing wrapped tobacco filler rods or the like. Pallmann or Morgan teach the apparatus and method of automatically inserting and removing a knife blade by unlocking the knife, removing the knife and replacing the knife with another knife fed in a linear manner from a storage device or magazine. One possessing ordinary skill in the art would have expected to make the manual knife changing method of Ringe to be automated as taught by the apparatus and method in the operation of the devices of Morgan or Pallmann, as the benefits such as reduced down time for the apparatus and increased operator safety that accrue to the use of automated exchanging devices is well-known and explicit in Pallmann (col. 1 and 2) and Morgan (page 1, lines 1-30).

Allowable Subject Matter

4. Claims 47 and 48 are allowed.

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5. The following is an examiner's statement of reasons for allowance: The prior art of record neither anticipates nor renders obvious an apparatus for replacing a first knife which is locked in a knife holder of a severing unit as claimed in claim 47 wherein the biasing member as claimed comprises at least one roller and the displacing member comprises a reciprocable bolt or the method of replacing the blade as claimed in claim 48, specifically with the steps including "removing the first knife from the holder by grasping the cutting edge of the first knife".

The closest prior art of record found is U.S. Pat. No. 3,830,126 (Ringe) in view of U.S. Pat. No. 5,217,424 (Pallmann) or U.S. Pat. No. 975,563 (Morgan).

Ringe teaches a rotating circular housing 27 for holding knife blades 28 for the cutting of a moving cigarette rod 19 (fig. 2, col. 5, lines 9-19). Ring states the holder 26 for the knife 28 is mounted in such a way "and in a manner known from the art of cutoffs for cigarette rods or the like" (col. 5, lines 12-15).

Ringe does not teach how the worn blades are removed from the holder.

Therefore Ringe does not anticipate the claimed invention of claims 47 and 48.

Pallmann teaches an automatic knife exchange method and device (col. 2, lines 44-50) for a circular knife ring and the method of replacing knives (col. 3, line 37- col. 4, lines 4). Pallmann teaches a method which includes a force-locking connection between the knife 5 and knife support plate 4 of the knife holder (col. 3, lines 44-46), means of moving the knife from the holder (col. 3, lines 47-53), introducing a second knife (col. 3, lines 51-59), locking the second knife into position (61-63). Pallmann teaches a force-locking means for locking and disengaging the knife from the knife holder 9 which includes a knife support plate 4 which holds the knife in place by clamping strip 7 and pressure screw 8 (col. 5, lines 34-48) and leaf spring 75 (col. 8,

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lines 40-46). Pallmann teaches an ejecting device 27 (fig. 1) with a cylinder 28, piston rod 29 and ejecting fork 30 for removal of the knife from the holder (col. 6, lines 33-37).

Pallmann does not teach the biasing member comprises at least one roller and the displacing member comprises a reciprocal bolt or removing the first knife from the holder by grasping the cutting edge of the first knife.

Therefore Ringe in view of Pallmann does not render obvious the claimed invention of claim 47 or 48.

Furthermore, there is no prior art of record that anticipates nor renders obvious the claimed invention of claim 47 or 48.

6. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

7. Applicant's arguments filed October 21, 2003 have been fully considered but they are not persuasive.

In response to applicant's comment that 43 claims are responded to by the Examiner in less than one page, Examiner's position is that due to the broadness of the 43 claims the rejection is sufficient to encompass the broadness of the claims.

Applicant asserts that "Ringe does not teach a cutter with a knife blade that can be exchanged" and "Ringe fails to disclose that the knife blades are replaceable even manually". Ringe teaches a knife ring that rotates to cut cigarette rods. Ringe addresses the need to have

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“clean cuts” in the severing operation (col. 1, lines 21-27). It would not be economically feasible for Ringe to dispose of the entire cylindrical housing 27 or holder 26 which supports the knife 28, when a blade becomes dull or broken. Ringe does not address the automatic process of replacing the blades when they become worn and no longer provide “clean cuts”, however it is well known in the art to replace a blade manual verses replace an entire machine system as is shown by Pallmann. It is also noted that it has been held that broadly providing an automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner 120 USPQ 192.

In response to Applicant’s assertion that “Ringe fails to support an obvious rejection based inherency”, Examiner notes that the above rejection is based on an “Obvious-Type” rejection. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well known in the art to replace worn blades automatically instead of replacing the entire cutting apparatus as is evidenced by Pallmann. The inherency argument as to Ringe is that it is inherent that when a blade becomes dull in an operation where “clean cuts” are a requirement, it is inherent that Ringe will replace the blades, even though Ringe does not address the replacement of the blades. The exchanging of knives in a knife holder is inherent in that though Ringe does not address how to replace the dulled or broken blades, it is inherent that the blades are replaced to maintain “clean cuts”. Examiner cites as evidence that it is well known

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in the art to replace worn blades instead of replace the entire machinery of the cutting operation by citing Pallmann and Morgan. Examiner disagrees with Applicant's position that it is not well known in the art to replace a worn blade, and as evidence that it is well known to replace worn blades Examiner refers Applicant to the teachings of Pallmann which provides a method of automatically changing the knife blades instead of replacing the entire knife ring. Examiner holds that it is well known in the art to replace the blades in a cutting process instead of replacing the entire machine, as is again evidenced by the above rejections using Pallmann.

In response to Applicant's assertion that "Knife blades that can be unlocked and replaced are not obvious", Applicant is referred to Pallmann in the above rejection which teaches an automatic knife replacement method and apparatus.

In response to Applicant's assertion that "Morgan and Pallmann are non-analogous art with respect to the present invention and Ringe, and thus, should not be relied upon as a basis for rejection of the Applicant's invention", Examiner is aware that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Ringe, Pallmann and Morgan teach a knife ring with blades for cutting which provides the method and apparatus that is reasonably pertinent to the particular problem of locking and unlocking blades on a cutter as claimed by Applicant. The purpose of the cited reference art is to cut through the use of a blade by the use of a revolving cutting device.

In response to Applicant's request for clarification on the prior art as to "automatically unlocking the knife" and "automatically locking", Applicant is referred to Pallmann col. 2, lines 45-51, col. 7, lines 22-26, column 8, lines 21-53, col. 9, lines 13-21, col. 9, lines 48-59, for example.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is (703) 305-7764. The examiner can normally be reached on Mon-Fri 7:00am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

dmr


A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700